

## **Remarks/Arguments**

### ***Status of the Claims***

The claims have not been amended.

The Examiner rejected claims 39-41, 66-68, 71, 73, 74 and 79 under 35 U.S.C. 102 and 103.

Applicants, in a Response dated March 20, 2008, previously amended claim 71, in order to distinguish it from the cited prior art references, to add the following limitation: “a *lug* that is removably mounted to an inside surface of the first opposed arm...”

### ***Remarks***

#### **• Priority**

In PAIR, the instant application is listed as a Division of Application No. 09/022,869, now U.S. Patent No. 6,562,037, with no reference to it being a continuation of Application No. 10/310,203, filed on December 4, 2002. The initial amendment filed on September 26, 2003, identified the priority as such and was filed within 4 months of the filing date of the instant application. The relevant section of the M.P.E.P. included below states that a petition and fees are not required, as per 37 C.F.R. 1.78(a)(3), as alleged by the Examiner.

#### **M.P.E.P. 201.11(III)(E)**

Form Paragraph 2.15 Reference to Prior Application, 35 U.S.C. 119(e) or 120 Benefit

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), , ***and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt*** the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filling an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

The “Utility Patent Application Transmittal” form, dated September 26, 2003, identifies the instant application as a divisional of prior application No. 09/022,869.

**35 U.S.C. 120 Benefit of earlier filing date in the United States**

An application for patent for an invention...which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application *or on an application similarly entitled to the benefit of the filing date of the first application* and if it contains or is amended to contain a specific reference to the earlier filed application.

Because the instant application was filed and claimed the priority benefit of an *application similarly entitled to the benefit of the filing date of the first application*, the instant application is entitled to said date. The instant application was filed as a continuation of 10/310,203, now U.S. Patent No. 7,025,764 B2, which was also a divisional of 09/022,869, now U.S. Patent No. 6,562,037. Therefore, Applicants believe that the priority benefit requirements have been fully complied with, and the instant application is entitled to the filing date of Application No. 09/022, 869, which is February 12, 1998.

- **102 rejection of claims 39-41, 66-68, 71, 73, 74, and 79**

Given the priority issue with the Paton et al. reference, Applicants believe that this rejection has been addressed by the correctly identified reference to the parent application. Therefore, this rejection is rendered moot.

- **103 rejection of claim 71 over Auth in view of Goble et al.**

Applicants believe that the substantive amendment to independent claim 71 patentably distinguishes the claims from the cited prior art references. Neither Auth nor Goble disclose "a lug that is removably mounted to an inside surface of the first opposed arm..." Examiner alleges that Auth's disclosure of the stop being selectable to be a specific thickness (col. 7, lines 66-67) can be inferred to mean that the stop may be replaced and is therefore removable. However, this is not the case.

Auth discloses that an insulating stop is incorporated to prevent the complete closure of the forceps in the absence of intervening tissue (col. 7 lines 25-31). Therefore, metal-to-metal contact is not possible, eliminating microwelding of the metal jaws 16, 18 in Figure 1 and carbonization buildup from microscopic residual debris (col. 7 lines 31-34). Auth further discloses that incorporation of the insulating stop 60 in Figure 1 provides end-on-spot-coagulation (34-36). In this mode of operation, the surgeon closes the forceps 10 as far as they can go, i.e., up to the point of pressure on the insulating stop 60 (col. 7 lines 36-39).

There is no reference in Auth to "a lug that is removably mounted to an inside surface of the first opposed arm, the lug being adapted to contact the second opposed arm, and when in contact to limit the extent to which the forceps may be deformed, the lug further preventing the overexertion of pressure on grasped tissue by limiting the maximum force transferred to the tissue, despite increased pressure exerted on the

forceps by a user.” In other words, Auth does not disclose the lug being used to prevent the overexertion of pressure, but rather simply that pressure is applied. There is no disclosure in Auth of limiting the pressure that is applied. Therefore, Auth does not disclose the particular limitation of a lug that prevents the overexertion of pressure.

Auth fails to disclose the electrodes on the tips of the arms. In fact, Auth teaches away from having the electrodes directly touch the tissue in order to avoid the tissue sticking to them (col. 1 line 67-col. 2 line 10, col. 3 lines 3-5 and 14-17). Modifying Auth in view of Goble et al. does not overcome the lack of this limitation. Although Goble et al. disclose the use of electrodes that directly touch the tissue, Auth teaches against the electrodes touching the tissue. Therefore, a modification of Auth in view of Goble et al. to yield the instant invention would not have been obvious to one of ordinary skill in the art at the time of the invention because Goble et al. teach the use of electrodes touching tissue in direct contrast to the teachings of Auth.

### ***Conclusion***

In view of the foregoing amendments, Applicants respectfully ask that the finding of non-compliance and rejections be withdrawn. Believing that all things raised in the Examiner’s April 29, 2010, Office Action have been addressed, the undersigned respectfully requests that the application be allowed and passed to issue.

Respectfully submitted,



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